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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SCHWABE, WILLIAMSON & WYATT, P.C. 1420 FIFTH, SUITE 3010 SEATTLE, WA 98101			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2424	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/910,656

Applicant(s)

WATTS ET AL.

Examiner

MICHAEL VAN HANDEL

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 9, 10, 13-15, 18, 20-22, 26, 29-37 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9, 10, 13-15, 18, 20-22, 26, 29-37, 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 12/01/2008. Claims **1-3, 6, 7, 9, 10, 13-15, 18, 20-22, 26, 29-37, 41-43** are pending. Claims **1, 13, 32, 41, 42** are amended. Claims **4, 5, 8, 11, 12, 16, 17, 19, 23-25, 27-28, 38-40** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **1, 13, 32, and 41**, filed 12/01/2008, have been fully considered, but they are not persuasive.

Regarding claims **1, 13, 32, and 41**, the applicant argues that Shoff et al. does not disclose a tag value that indicates a time value within the duration of the video content program and identifies a portion of subsidiary data as being associated with and to be displayed during a time segment of the primary content data. The examiner respectfully disagrees. As noted in the Office Action mailed 8/22/2008, Shoff et al. discloses an interactive entertainment system that enables presentation of supplemental interactive content along side traditional broadcast video programs (see Abstract). Each subscriber of the interactive entertainment system has a viewer computing unit 24. The viewer computing unit is a set-top box (STB) 26 coupled to a television (TV) 28 (col. 4, l. 22-25). When a viewer tunes to a particular channel, the STB determines if the program is interactive. If it is, the STB launches an interactive support module (col. 3, l. 14-18). The STB then displays the supplemental content concurrently with the video content program (col. 3, l. 45-47).

As further noted in the Office Action mailed 8/22/2008, Shoff et al. discloses that interactive content can be supplied locally on a storage medium, such as a CD-ROM (col. 7, l. 61-67 & col. 8, l. 52-55). A content developer creates the interactive CD-ROM (col. 7, l. 63-65). Shoff et al. further discloses that the content developer is the same provider that distributes the video content program (col. 3, l. 10-12). Shoff et al. discloses that the supplemental content is synchronized with the program by using the frame count of the video (col. 7, l. 67; col. 8, l. 1-3; & col. 10, l. 7-17, 34-43). The supplemental content is displayed according to a display layout and synchronized to the program according to the frame count of the program (col. 8, l. 1-3; col. 10, l. 7-17, 56-58; & col. 11, l. 59-65). Shoff et al. further discloses transmitting timing information for synchronizing the presentation of the supplemental content with the video content program. The program is characterized in terms of frames and the introduction of supplemental content is keyed to the frame numbers. The timing information is transmitted together with the video stream and transmitted as one signal from the headend (col. 10, l. 7-22). The digital data is deconstructed at the viewer computing unit to extract the timing information and display layout (col. 10, l. 34-37). The supplemental content is displayed according to the display layout and synchronized to the program according to the timing information (col. 10, l. 50-52). The examiner interprets the video frame numbers to be tag values indicating a time value within the duration of the video content program and identifying a portion of subsidiary data as being associated with and to be displayed during a time segment of the primary content data, as currently claimed.

Further regarding claim **41**, the applicant argues that Shoff et al. does not disclose using elapsed time to retrieve subsidiary data. The examiner respectfully disagrees. The applicant

specifically argues that Shoff et al. discloses that the target specification within the program guide is used to access a resource, digital data is received from the resource, and the digital data is then reconstructed to extract the timing information used for synchronization. The applicant further specifically argues that Shoff et al. necessarily teaches retrieving the subsidiary data from the target resource and then extracting the timing information from the subsidiary data that allows for synchronization by elapsed time. The examiner notes; however, that the time elapsed from the start of the program in Shoff et al. is determined from the programming guide by way of the target specification. Upon receiving the digital data, additional content will be retrieved at event times within the program as determined by elapsed time or frame count (see Tables 1 & 2)(col. 13 & 14). That is, upon reaching a certain time in the program, a TRIGGER will be activated (col. 14, l. 25-30). The TRIGGER will be associated with an ACTION to take through the EVENT tag (col. 13, l. 62-67). The ACTION tag defines further URLs to resources for objects to be displayed as part of the ACTION (col. 13, l. 55-60). Since Shoff et al. discloses that, upon receiving the initial HTML document, additional supplemental content will be retrieved based on elapsed time of the program, the examiner maintains that Shoff et al. meets the limitations of “determining, by a set-top system, a time elapsed from a scheduled start of a program based on a programming guide including the scheduled start, the program to be displayed over a plurality of time segments” and “retrieving, by the set-top system, a portion of subsidiary data associated with a time segment of the program, the portion of subsidiary data being retrieved based at least on the determined time elapsed,” as currently claimed.

Still further regarding claim 41, the applicant argues that the passages of Shoff et al. cited by the examiner teaches away from claim 41. The examiner respectfully disagrees. The

examiner notes that arguments that the alleged anticipatory prior art teaches away from the invention are not germane to a rejection under section 102. The question whether a reference “teaches away” from the invention is inapplicable to an anticipation analysis. See **MPEP 2131.05**.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-3, 6, 7, 9, 10, 13-15, 18, 20-22, 26, 29-37, 41-43** are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al.

Referring to claim **1**, Shoff et al. discloses a method/medium/entertainment system comprising:

- receiving primary content data at a set-top system 26 (Fig. 2) from an external source 42, the primary content data encoding a video content program and including at least one tag value, the tag value indicating a time value within the duration of the video content program and identifying a portion of subsidiary data as being associated with and to be displayed during a time segment of the primary content data, the primary content data to be displayed over a plurality of time segments (the examiner interprets the frame numbers and timing

- information as being tag values)(col. 6, l. 49-67; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 63-67; col. 10, l. 7-17, 34-43, 50-58; & Figs. 2, 3, 5, 6);
- accessing a storage storing a plurality of subsidiary data, including the identified subsidiary data, and retrieving the portion of subsidiary data based on the tag value (col. 3, l. 4-10, 42-47; col. 6, l. 16-22; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 38-44, 52-55, 64-67; & col. 10, l. 7-17); and
 - generating an output signal including the primary content data and the identified subsidiary data for display, with the identified subsidiary data being displayed concurrently with the primary content data during the time segment (col. 9, l. 27-40 & Fig. 8c).

Referring to claims **2** and **14**, Shoff et al. discloses the method/medium of claims 1 and 13, respectively, further comprising:

- receiving the identified subsidiary data from the external source prior to beginning receipt of the primary content data (col. 3, l. 10-13, 42-47; col. 7, l. 61-67; col. 8, l. 52-55; & col. 9, l. 23-25); and
- storing the identified subsidiary data locally in the storage (col. 3, l. 42-47 & col. 8, l. 52-55).

Referring to claims **3**, **15**, and **26**, Shoff et al. discloses the method/medium/entertainment system of claims 2, 14, and 32, respectively, wherein receiving the identified subsidiary data comprises obtaining the identified subsidiary data from a local nonvolatile storage medium of the set-top system (col. 7, l. 61-67 & col. 8, l. 52-55).

Referring to claim **6**, Shoff et al. discloses the method of claim 1, wherein the primary content data comprises data of at least one of a television broadcast, a digital satellite broadcast, an Internet broadcast, and an audio-only broadcast (col. 4, l. 62-67 & col. 5, l. 1-5).

Referring to claims **7** and **18**, Shoff et al. discloses the method/medium of claims 1 and 13, respectively, further comprising determining the identity of the primary content data currently displayed via reading an identifier associated with the primary content data (col. 5, l. 61-67; col. 6, l. 1-28; col. 8, l. 62-67; & col. 9, l. 1-5).

Referring to claims **9** and **20**, Shoff et al. discloses the method/medium of claims 1 and 13, respectively, further comprising retrieving the identified subsidiary data from a remote server (col. 5, l. 12-23 & col. 7, l. 26-50, 61-67).

Referring to claims **10**, **21**, and **30**, Shoff et al. discloses the method/medium/system of claims 1, 13, and 32, respectively, wherein the identified subsidiary data comprises at least one of reference information regarding a program of the primary content data, biographical information regarding actors, guests or participants of a program of the primary content data (col. 5, l. 16-23).

Referring to claim **13**, Shoff et al. discloses a machine-readable medium having stored thereon programming instructions, comprising:

- instructions to receive primary content data at the set-top system 24 (Fig. 2) from an external source 42, the primary content data corresponding to a video content program and including at least one tag value, the tag value identifying a time value for the video content program and identifying a portion of subsidiary

data to be displayed during a time segment of the primary content data, the primary content data to be displayed over a plurality of time segments (the examiner interprets the frame numbers and timing information as being tag values)(col. 6, l. 49-67; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 63-67; col. 10, l. 7-17, 34-43, 50-58; & Figs. 2, 3, 5, 6);

- instructions to access a storage storing a plurality of subsidiary data, including the portion of subsidiary data, and retrieve the identified subsidiary data based on the tag value (col. 3, l. 4-10, 42-47; col. 6, l. 16-22; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 38-44, 52-55, 64-67; & col. 10, l. 7-17); and
- instructions to generate an output signal including the primary content data and the identified subsidiary data for displaying, with the identified subsidiary data being displayed concurrently with the primary content data during the time segment (col. 9, l. 27-40 & Fig. 8c).

Referring to claim **22**, Shoff et al. discloses the machine-readable medium of claim 18, wherein the instructions for reading the identifier are performed in response to a change in the primary content data currently displayed (col. 8, l. 62-67 & col. 9, l. 1-8).

Referring to claim **29**, Shoff et al. discloses the entertainment system of claim 32, wherein the storage database includes an identification of a remote server from which subsidiary data may be retrieved and wherein the controller is to request retrieval of the subsidiary data from the identified remote server (col. 5, l. 12-23).

Referring to claim **31**, Shoff et al. discloses the entertainment system of claim 32, wherein the second controller is to determine the identity of the primary content data in response to a change in the primary content data currently displayed (col. 8, l. 62-67; col. 9, l. 1-8).

Referring to claim **32**, Shoff et al. discloses an entertainment system 62 90 (Figs. 4, 5) comprising:

- a data receiver 98 (Fig. 5) to receive primary content data from an external source, the primary content data including at least one tag value, the tag value indicating a time value and identifying a portion of subsidiary data associated with the primary content data, the display of the portion of subsidiary data being synchronized with the display of the primary content data using at least the time value identified by the tag value, the primary content data to be displayed over a plurality of time segments (the examiner interprets the frame numbers and timing information as being tag values)(col. 6, l. 49-67; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 63-67; col. 10, l. 7-17, 34-43, 50-58; & Figs. 2, 3, 5, 6);
- a storage database to store a plurality of subsidiary data supplemental to the primary content data received from the external source prior to receipt of the primary content data, the plurality of subsidiary data including the identified subsidiary data (col. 3, l. 4-10, 42-47; col. 6, l. 16-22; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 38-44, 52-55, 64-67; & col. 10, l. 7-17); and
- a controller coupled to the data receiver and the storage database to retrieve the identified subsidiary data based on the tag value (col. 3, l. 4-10, 42-47; col. 6, l.

16-22; col. 7, l. 1-8, 61-67; col. 8, l. 1-3, 38-44, 52-55, 64-67; & col. 10, l. 7-17), with the identified subsidiary data to be displayed concurrently with the primary content data during the time segment (col. 9, l. 27-40 & Fig. 8c).

Referring to claim **33**, Shoff et al. discloses the entertainment system of claim 32, further comprising a second controller coupled to the controller to combine the primary content data with the identified subsidiary data and forward the combined data to a display (computing unit 62 uses the received digital data in order to synchronize the supplemental data with the primary program so computing unit 62 must have video/audio logic)(col. 9, l. 66-67 & col. 10, l. 1-17, 34-58).

Referring to claim **34**, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is further configured to receive and store the identified subsidiary data in the storage database (col. 8, l. 4-34, 52-55 & Fig. 5).

Referring to claim **35**, Shoff et al. discloses the entertainment system of claim 32 wherein the controller is to allow a user to interact with the storage database (col. 8, l. 4-34, 52-55 & Fig. 5).

Referring to claim **36**, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is to allow a user to access a programming guide (col. 8, l. 38-44).

Referring to claim **37**, Shoff et al. discloses the entertainment system of claim 32, wherein the controller is to allow a user to toggle enablement of the subsidiary data (col. 8, l. 4-34, 52-55; col. 9, l. 42-59; col. 11, l. 45-47; & Fig. 5).

Referring to claim **41**, Shoff et al. discloses a method comprising:

- determining by a set-top system, a time elapsed from a scheduled start of a program (col. 10, l. 7-14) based on a programming guide including the scheduled start (col. 6, l. 1; col. 8, l. 62-67; & Fig. 3), the program to be displayed over a plurality of time segments (col. 10, l. 50-52, 55-58 & col. 14, l. 25-30);
- retrieving, by the set-top system, a portion of subsidiary data associated with a time segment of the program, the portion of subsidiary data being retrieved based at least on the determined time elapsed (col. 10, l. 7-17, 50-53, 55-58; col. 13, l. 30-67; & col. 14, l. 1-30); and
- synchronizing, by the set-top system, the retrieved portion of subsidiary data associated with the time segment of the program for concurrent display with the program during the time segment (col. 10, l. 7-17, 50-53, 55-58; col. 12, l. 44-47; col. 13, l. 30-67; & col. 14, l. 1-30).

Referring to claim **42**, Shoff et al. discloses the method of claim 41, wherein the retrieving comprises retrieving the portion of subsidiary data from a remote server (col. 9, l. 66-67; col. 10, l. 1-17; col. 13, l. 50-67).

Referring to claim **43**, Shoff et al. discloses the method of claim 42, wherein the retrieving comprises obtaining a locator of the remote server based on the time segment (col. 9, l. 66-67; col. 10, l. 1-17; & col. 13, l. 50-67).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL VAN HANDEL** whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit
2424

MVH